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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,108	03/29/2001	Maria A. Himmel	AUS8-2001-0188-US1	3261

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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/821,108

Applicant(s)

HIMMEL ET AL.

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### **Response To Applicant's Arguments**

First and foremost, the Applicant's arguments are based on the current amendments to claims 1, 8 and 15. Here, the Applicant submits that these amendments encompass a "pulling" of advertisements by a mobile station and that the teachings of Hendrey and Gupta alone or in combination focus rather on "pushing" of advertisements to a mobile station and therefore, the combination of Hendrey and Gupta clearly teaches away from "pulling" advertisements to the mobile station based on one or more received keywords. However, the Examiner respectfully and completely disagrees with the Applicant's findings. What is at stake here is whether or not the combination of the prior art of record discloses a system for providing an advertising message to a user of a mobile terminal along with requested information (keyword). And the combination of the prior art has in fact read on the amended claims. Further, the manner in which the advertisement is retrieved or provided either by "pulling" or "pushing" is a matter of convenience, which does not impact the functionality of the system or the retrieval and distribution of the advertising message per se. In other words, whether or not the advertising message was "pulled" or "pushed", the system is operable when receiving a request from a user of a mobile unit to provide an advertising message along with the requested information. And the combination of the prior art of record, namely the Hendrey's and Gupta's Patents, has provided such a system. Moreover, in the new claim limitations "receiving one or more keywords from the mobile station **for purposes of pulling** at least one advertisement to the mobile station", "**for purposes of pulling**" simply recite a functional limitation. Here, the test is whether or not the prior art structure is capable of performing the disclosed function. And as shown above and in the Office Action, the prior art structure is capable of performing the disclosed function.

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Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the last Office Action, as shown below, is hereby maintained and the current Office Action has been made Final.

### **DETAILED ACTION**

#### *Specification*

#### *Information Disclosure Statement*

The information disclosure statement filed August 23, 2004 fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). Since the Applicant authorizes the Office to charge any required fee, the Applicant's account will be debited for considering the Supplemental IDS.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered

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therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendrey et al (hereinafter Hendrey), US Patent 6, 647, 269B2, in view of Gupta et al. (hereinafter Gupta), US Patent 6, 487, 538 B1.

As per claims 1, 2, 3, 4, 5, 6 and 7, Hendrey teaches a method and system for analyzing a targeted advertisements delivered to a mobile unit, wherein location information of the mobile unit and a the profile (preferences) of the user of the mobile unit are used to generate a targeted advertisement for the user and wherein the location of the mobile unit and the user's preferences match a local business location and preferences. Upon detecting the presence of the mobile unit in the local business geographic area or radius (as covered by a base station), an advertisement, tailored to the user's psychographic profile, for the business is transmitted to the mobile unit. Subsequent to this transmission, the position of the user or the mobile unit is monitored or tracked to determine the effectiveness of the transmitted advertisement (verifying reception). If the user enters the business location or store and/or makes a timely purchase associated with an item featured in the advertisement and sold at the business store, then the advertisement is recorded or logged as being successful. Furthermore, if the user has not entered the store within a preset period of time subsequent to receiving the advertisement or moves away from the store, then the advertisement has failed. (See abstract; fig. 1-2; col. 1: 55 to col. 2: 40; col. 3: 18-23; col. 4: 28-45; col. 5: 13-25).

As per claims 1, 2, 3, 4 and 5, although Hendrey teaches providing a targeted advertisement to the user of the mobile unit in accordance with the user's mobile unit location (service station or coverage area) and the user's profile matching an advertiser's specifications, however, Hendrey does not expressly disclose receiving a keyword from the user of the mobile unit and wherein the keyword or request, associated with an advertiser's profile, and/or the user's

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mobile unit location and/or the user's profile is (are) used to generate a targeted advertisement for the user.

However, Gupta discloses a system for distributing push content or advertisements to a user when the user requests a primary or first predetermined information or a web page from a web site or content provider wherein the push content or advertisements is displayed to the user in accordance with the user's profile, credit history and web sites visited and search queries, having specific keywords or terms, conducted by the user (See abstract). Furthermore, Gupta discloses an advertisement negotiation system wherein an advertiser evaluates the user's profile and based on this evaluation, the advertiser may decide how much money he wants to pay in order to have his advertising messages displayed to a user, having a particular matching profile, who requests via an ISP a primary information or a specific web page related to a specific web site (col. 5: 66 to col. 6: 45; col. 11: 42 to col. 12: 50). In addition, the system can include in the user's request the type of advertisements (advertisement characteristics) that are acceptable or can be displayed or inserted in the web page that is returned to the user by appending an HTML tag in the user's request specifying the advertisement characteristics (col. 15: 19-31). In short, a profile is useful in determining the type of advertisement to display to a targeted user based on a profile matching between the user's profile and the advertiser's specifications or criteria to display an ad. For example, if the user's profile indicates that the user of the client 100 executed a search for flowers (keyword=flowers), then the advertiser may desire to transmit an advertisement or ad related to a local flower shop to the user via client 100 connected over the Internet. Furthermore, if the user accesses or requests a Pizza Hut web page, then an

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advertisement for Round Table Pizza or Dominos Pizza, a competitor's brand, may be displayed next time the user accesses a website (col. 10: 9-22; col. 10: 41-63). Moreover, an ADRESTRICT tag may specify the categories/types of advertisements to allow/deny. For instance, a religious web site may desire to exclude any advertisement for pornographic web sites or to allow only advertisements for books. In other words, when the user requests via the ISP primary information available at a religious web site, the ISP/proxy server cannot insert advertisements related to pornographic materials or pornographic web sites (col. 15: 51-56). Moreover, The advertiser or the manufacturer or the coupon distributor himself may restrict the ISP/proxy server to only insert advertisements (coupons) on web pages from chosen web sites, thereby automatically excluding the web sites that were not chosen as being suitable web sites (col. 17: 9-12).

In summary, Gupta teaches a system for providing a targeted advertisement to a user along with a requested web page, based on the user's profile, based on previously visited websites and keywords or search terms submitted in a user's request matching an advertiser's preferences or specifications, via a client 100 over a communication network or the Internet or a wireless link (See abstract; col. 17: 9-12; col. 7: 60-63).

Finally, it is common practice to provide a targeted advertisement to a user contingent upon the user's profile and/or the user's request (keyword). For example, a user, who orders or requests a VOD (video on demand) or a PPV (pay per view) program, receives delivery of the VOD along with an embedded advertisement, scheduled to be displayed during a program break



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or interruption, based on the user's profile and/or the type of VOD or PPV ordered or requested (context ad).

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into the Hendrey's system so as to enable a user of a mobile unit to input via a wireless browser a keyword or a request for information, such as flowers, over a wireless link while being in a geographical area related to an advertiser's business and to transmit a targeted advertisement to the user based on the inputted keyword or request, the user's profile and the current location of the mobile unit matching the location of the business, wherein the user's mobile unit position is tracked following the transmission of the advertisement to determine whether the user enters a store related to the business and/or buys a product featured in the displayed advertisement and sold at the store, thereby measuring the effectiveness of the transmitted advertisement while using the keyword, profile and location matching not only to effectively deliver targeted advertisements to the user of the mobile unit upon detecting the user's presence in an advertiser's local business geographic area when the user initiates a request or makes a phone call via his mobile unit, but also to structure advertisement prices targeted at the users of the mobile units.

Claims 8-14 recite limitations already addressed in claims 1-7 respectively and therefore, these limitations of claims 8-14 are rejected under a similar rationale as applied to claims 1-7 respectively.

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Claims 15-21 recite limitations already addressed in claims 1-7 respectively and therefore, these limitations of claims 15-21 are rejected under a similar rationale as applied to claims 1-7 respectively.

### **Conclusion**

Although the following references were not officially used in the Office Action, they were highly considered.

US Patent 6, 484, 148 to Boyd discloses a system for providing targeted advertisements to a user of a mobile unit based on the location of the mobile unit and the user's profile.

US Patent 6,526,335 discloses an automobile personal computer system. A user of the system may wirelessly interact with merchants, communications facilities, information providers, computers at the home or office, and other entities. Such interactions may involve local wireless links and remote wireless links. Wireless communications may involve satellite transmissions, cellular transmissions, short-range wireless transmissions, etc. Products may be purchased using voice commands or by interacting with displays in the automobile. The automobile's location and functions may be monitored and controlled. Location information and other information particular to the user may be used to target promotions to the user. The user may obtain information on the goods or services available at a merchant while driving and may initiate a purchase transaction for those goods or services.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

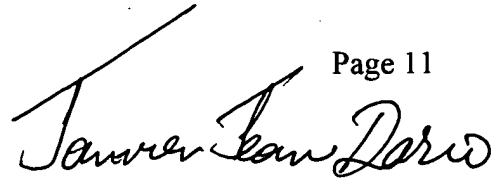
Application/Control Number: 09/821,108

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JDJ

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A handwritten signature in cursive script, reading "Janvier Jean David".

Jean D. Janvier

Patent Examiner

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